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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/607,330 | 06/26/2003 | Armand Malnoe | 112701-365 | 4205 |
| 29157 | 7590 | 06/21/2006 | EXAMINER | |
| BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135 | | | MCCORMICK EWOLDT, SUSAN BETH | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1655 | |

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,330

Applicant(s)

MALNOE ET AL.

Examiner

S. B. McCormick-Ewoldt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 9, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,8,10,11,14,16,18 and 23-64 is/are pending in the application.
- 4a) Of the above claim(s) 23-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3,4,6,8,10,11,14,16,18 and 63-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 9, 2006 has been entered.

The amendment of April 10, 2006 is hereby acknowledged and entered.

Applicant elected Group I and chicory in the Restriction Requirement dated February 8, 2005.

Claims Pending

Claims 1, 3-4, 6, 8, 10-11, 14, 16, 18 and 63-64 are pending. Applicant has cancelled claims 2, 5, 7, 9, 12-13, 15, 17, 19-22. Claims 23-62 have been withdrawn from consideration. Claims 1, 3-4, 6, 8, 10-11, 14, 16, 18 and 63-64 will be examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Written Description

The claims are drawn to the family *Asteracea* and methods of extracting the claimed chicory plant. In analyzing whether the written description requirement is met for genus claims, it is determined whether a representative number have been described. In this case, the one

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disclosed embodiment is not representative of the enormous number of plants claimed. *Asteracea* contains thousands of different plants species. The specification only provides plants of chicory. Therefore, Applicant is not in possession of the claimed plant at the time this application was filed and lacks an adequate written description.

Claims 6 and 14 either recite, or depend upon a claim which recites “chicory extract.” It is deemed that Applicant has not set forth a representative number of examples in order to reasonably verify possession of such a potentially enormous number of extracts.

The MPEP states that written description for a genus can be achieved by a representative number of species within a broad generic. It is unquestionable that the claims are broad generics, with respect to *all* extracts. The possible variations of extracts are limitless. Although Applicant has disclosed some solvents which could potentially be used to extract chicory, this disclosure is actually a *very few* number in comparison to the enormous, *potentially millions* of types of extracts which could be obtained from chicory. The reason for this large amount of permutations is because extraction techniques are often coupled in order to obtain a product; for example

- 1) a water extraction followed by an alcoholic extraction: the product obtained is an extract.
- 2) a supercritical extraction (CO₂) followed by an alcoholic and then a non-polar solvent extraction (e.g., chloroform): the product is an extract.
- 3) a benzene extraction followed by a water extraction and chromatographic separation: the product is an extract.
- 4) a water/chloroform extraction (e.g., in a separatory funnel), followed by collection of the water layer, chromatographic separation and crystallization of an isolate: the product is an extract.
- 5) squeezing the plant to obtain a juice: the product is an extract.
- 6) dipping the plant in an organic solvent to remove the waxy layer: the product is an extract.

The MPEP states that the purpose of the written description requirement is to ensure that the invention had possession, as of the filing date of the application, of the specific subject matter later claimed by him or her. The courts have stated:

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“To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention.” *Lockwood v. American Airlines, Inc.*, 107 F. 3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Gostelli*, 872 F. 2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (“[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”). Thus, an Applicant complies with the written description requirement “by describing the invention, with all its claimed limitations, no that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood*, 107 F. 3d at 1572, 41 USPQ2d at 1966. *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398. The specification lacks sufficient variety of species of extracts to reflect this variance in the genus since the specification does not provide sufficient examples of such a genus of extracts.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736, F. 2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does “little more than outline [goals] appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.”) Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of “extract” and does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the entire scope of the claimed invention and thus, this rejection is proper.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 4, 6 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Anantharaman *et al.* (US 5,952,033).

Anantharaman *et al.* (US 5,952,033) expressly teaches using a plant material extract (i.e. chicory) in a composition, which includes a starch source, a protein source and a fat source. The amount of chicory extract used is about 1% to about 5% by weight (column 3, lines 23-66; column 6, lines 42-43). Anantharaman meets the limitations of claim 1 as the composition comprises chicory extract and the starch source, protein source and fat source in amounts from 1% to 5% and thus anticipates the claimed invention.

Applicant is requested to note that it is regarded that “intended use” of a composition will not further limit claims drawn to a composition. See, e.g., *Ex Parte Masham*, 2 USPQ2d 1647 (1987) and *In Re Hack* 114, USPQ 161. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anantharaman *et al.* (US 5,952,033) in view of Hermand (US 6,645,534 B2).

Anantharaman *et al.* (US 5,952,033) disclose using a plant material extract (i.e. chicory) in a composition, which includes a starch source, a protein source and a fat source. The amount of chicory extract used is about 1% to about 5% by weight (column 3, lines 23-66; column 6, lines 42-43).

Anantharaman does not teach wherein the extract is thermally extracted or wherein the chicory extract is used to inhibit inflammation.

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Hermant (US 6,645,534 B2) discloses that chicory is capable of pharmacological properties such as anti-inflammatory efficacies. In addition, Hermant teaches extracting chicory by hot extraction method (i.e. thermal) (column 1, lines 21-27; column 2, lines 38-41).

One of ordinary skill in the art would have been motivated to use chicory extract along with a starch, a protein and a fat in a composition because of the anti-inflammatory properties that chicory contains. It was clear from the Anantharaman reference that a plant material extract (i.e. chicory) is used in a composition, which includes a starch source, a protein source and a fat source with the amount of chicory extract about 1% to about 5% by weight. It was further clear from the Hermant reference that that chicory has anti-inflammatory properties and can be thermally extracted. Although neither reference discloses the active fragment of α -methylene- γ -butyrolactone, it would be inherent to the composition. Therefore, one of ordinary skill in the art would have had a reasonable expectation to use chicory in a composition because of the anti-inflammatory properties it contains.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

Summary

No claim is allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terry McKelvey, can be reached on (571) 272-0775. The official fax number for the group is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

A handwritten signature in black ink, appearing to read 'CR Tate', with a stylized flourish at the end.

**CHRISTOPHER R. TATE
PRIMARY EXAMINER**